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09/823,588	03/30/2001	S. Sean Moore	UV/192	6830

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EXAMINER

LASTRA, DANIEL

ART UNIT PAPER NUMBER

3622

DATE MAILED: 09/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/823,588

Applicant(s)

MOORE ET AL.

Examiner

DANIEL LASTRA

Art Unit

3622

NW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-53 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-53 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 01/22/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

1. Claims 1-53 have been examined. Application 09/823,588 (SYSTEM AND METHOD FOR METADATA-LINKED ADVERTISEMENTS) has a filing date 03/30/2001 Claims Priority from Provisional Application 60193948 (03/31/2000).

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-36 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 1-36 are not within the technological arts.

As an initial matter, the United States Constitution under Art. I, §8, cl. 8 gave Congress the power to "[p]romote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries". In carrying out this power, Congress authorized under 35 U.S.C. §101 a grant of a patent to "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition or matter, or any new and useful improvement thereof." Therefore, a fundamental premise is that a patent is a statutorily created vehicle for Congress to confer an exclusive right to the inventors for "inventions" that promote the progress of "science and the useful arts". The phrase "technological arts" has been created and used by the courts to offer another view of the term "useful arts". See *In re Musgrave*, 167 USPQ (BNA) 280 (CCPA 1970). Hence, the first test of

Art Unit: 3622

whether an invention is eligible for a patent is to determine if the invention is within the "technological arts".

Further, despite the express language of §101, several judicially created exceptions have been established to exclude certain subject matter as being patentable subject matter covered by §101. These exceptions include "laws of nature", "natural phenomena", and "abstract ideas". See *Diamond v. Diehr*, 450, U.S. 175, 185, 209 USPQ (BNA) 1, 7 (1981). However, courts have found that even if an invention incorporates abstract ideas, such as mathematical algorithms, the invention may nevertheless be statutory subject matter if the invention as a whole produces a "useful, concrete and tangible result." See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* 149 F.3d 1368, 1973, 47 USPQ2d (BNA) 1596 (Fed. Cir. 1998).

This "two prong" test was evident when the Court of Customs and Patent Appeals (CCPA) decided an appeal from the Board of Patent Appeals and Interferences (BPAI). See *In re Toma*, 197 USPQ (BNA) 852 (CCPA 1978). In *Toma*, the court held that the recited mathematical algorithm did not render the claim as a whole non-statutory using the Freeman-Walter-Abele test as applied to *Gottschalk v. Benson*, 409 U.S. 63, 175 USPQ (BNA) 673 (1972). Additionally, the court decided separately on the issue of the "technological arts". The court developed a "technological arts" analysis:

The "technological" or "useful" arts inquiry must focus on whether the claimed subject matter...is statutory, not on whether the product of the claimed subject matter...is statutory, not on whether the prior art which the claimed subject matter purports to replace...is statutory, and not on whether the claimed subject matter is presently perceived to be an improvement over the prior art, e.g., whether it "enhances" the operation of a machine. *In re Toma* at 857.

Art Unit: 3622

In *Toma*, the claimed invention was a computer program for translating a source human language (e.g., Russian) into a target human language (e.g., English). The court found that the claimed computer implemented process was within the "technological art" because the claimed invention was an operation being performed by a computer within a computer.

The decision in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* never addressed this prong of the test. In *State Street Bank & Trust Co.*, the court found that the "mathematical exception" using the Freeman-Walter-Abele test has little, if any, application to determining the presence of statutory subject matter but rather, statutory subject matter should be based on whether the operation produces a "useful, concrete and tangible result". See *State Street Bank & Trust Co.* at 1374. Furthermore, the court found that there was no "business method exception" since the court decisions that purported to create such exceptions were based on novelty or lack of enablement issues and not on statutory grounds. Therefore, the court held that "[w]hether the patent's claims are too broad to be patentable is not to be judged under §101, but rather under §§102, 103 and 112." See *State Street Bank & Trust Co.* at 1377. Both of these analysis goes towards whether the claimed invention is non-statutory because of the presence of an abstract idea. Indeed, *State Street* abolished the Freeman-Walter-Abele test used in *Toma*. However, *State Street* never addressed the second part of the analysis, i.e., the "technological arts" test established in *Toma* because the invention in *State Street* (i.e., a computerized system for determining the year-end income, expense, and capital gain or loss for the portfolio) was already determined to be within

the technological arts under the *Toma* test. This dichotomy has been recently acknowledged by the Board of Patent Appeals and Interferences (BPAI) in affirming a §101 rejection finding the claimed invention to be non-statutory. See *Ex parte Bowman*, 61 USPQ2d (BNA) 1669 (BdPatApp&Int 2001).

In the present application, independent claims 1, 18, 32 and 36 recite a “useful, concrete and tangible result” (method of providing advertisement with other media), however the claims recite no structural limitations (i.e., computer implementation), and so they fail the first prong of the test (technological arts). Dependent claims 2-17, 19-31 and 33-35 do not remedy this situation as no structural limitations are recited.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-34 and 36-53 are rejected under 35 U.S.C. 102(e) as being anticipated by Srinivasan et al (U.S. 6,357,042).

As per claim 1, Srinivasan teaches:

A method for providing advertisements with other media comprising:

selecting an object within a viewing plane of a viewing device (see column 32, line 21 – column 33, line 3);

reading metadata associated with the object (see column 32, line 21 – column 33, line 3); and

selecting an advertisement based on the metadata (see column 32, line 21 – column 33, line 3).

As per claim 2, Srinivasan teaches:

The method of claim 1 further comprising displaying the advertisement on the viewing device (see column 32, lines 21-64).

As per claim 3, Srinivasan teaches:

The method of claim 1 wherein the selecting of the object is based on user input (see column 32, lines 21-31).

As per claim 4, Srinivasan teaches:

The method of claim 1 further comprising receiving the metadata (see column 32, lines 22-56).

As per claim 5, Srinivasan teaches:

The method of claim 4 wherein the metadata is received within other media (see column 36, lines 10-25).

As per claim 6, Srinivasan teaches:

The method of claim 4 wherein the metadata is received on a broadcast channel on which other media is also received (see column 31, lines 15-56).

As per claim 7, Srinivasan teaches:

The method of claim 4 wherein the metadata is received on a separate broadcast channel from other media (see column 31, lines 15-56).

As per claim 8, Srinivasan teaches:

The method of claim 1 further comprising storing the metadata (see column 32, lines 21-31).

As per claim 9, Srinivasan teaches:

The method of claim 8 wherein the metadata is stored on a single storage device (see figure 16; column 32, lines 21-31).

As per claim 10, Srinivasan teaches:

The method of claim 8 wherein the metadata is stored on a plurality of storage devices (see figure 16, column 32, lines 21-31).

As per claim 11, Srinivasan teaches:

The method of claim 1 further comprising receiving the advertisement (see column 32, lines 21-56).

As per claim 12, Srinivasan teaches:

The method of claim 11 wherein the advertisement received is received within other media (see column 32, lines 21-56).

As per claim 13, Srinivasan teaches:

The method of claim 11 wherein the advertisement is received on a broadcast channel on which other media is also received (see column 31, lines 15-56).

As per claim 14, Srinivasan teaches:

The method of claim 11 wherein the advertisement is received on a separate broadcast channel from other media (see column 31, lines 15-56).

As per claim 15, Srinivasan teaches:

The method of claim 1 further comprising storing the advertisement (see column 32, lines 21-55).

As per claim 16, Srinivasan teaches:

The method of claim 15 wherein the advertisement is stored on a single storage device (see figure 16, column 32, lines 21-31) .

As per claim 17, Srinivasan teaches:

The method of claim 15 wherein the advertisement is stored on a plurality of storage devices (see figure 16, column 32, lines 21-31).

As per claim 18, Srinivasan teaches:

A method for providing advertisements with other media comprising:

receiving metadata reading metadata;

selecting an advertisement based on the metadata; and

displaying the advertisement. Claim 18 contains the same limitations as claim 1 therefore the same rejection is applied.

As per claim 19, Srinivasan teaches:

The method of claim 18 wherein the metadata received is received within other media. Claim 19 contains the same limitations as claim 5 therefore the same rejection is applied.

As per claim 20, Srinivasan teaches:

The method of claim 18 wherein the metadata is received on a broadcast channel on which other media is also received. Claim 20 contains the same limitations as claim 6 therefore the same rejection is applied.

As per claim 21, Srinivasan teaches:

The method of claim 18 wherein the metadata is received on a separate broadcast channel from other media. Claim 21 contains the same limitations as claim 7 therefore the same rejection is applied.

As per claim 22, Srinivasan teaches:

The method of claim 18 further comprising storing the metadata. Claim 22 contains the same limitations as claim 8 therefore the same rejection is applied.

As per claim 23, Srinivasan teaches:

The method of claim 22 wherein the metadata is stored on a single storage device. Claim 23 contains the same limitations as claim 9 therefore the same rejection is applied.

As per claim 24, Srinivasan teaches:

The method of claim 22 wherein the metadata is stored on a plurality of storage devices. Claim 24 contains the same limitations as claim 10 therefore the same rejection is applied.

As per claim 25, Srinivasan teaches:

The method of claim 18 further comprising receiving the advertisement. Claim 25 contains the same limitations as claim 11 therefore the same rejection is applied.

As per claim 26, Srinivasan teaches:

The method of claim 25 wherein the advertisement is received within other media. Claim 26 contains the same limitations as claim 12 therefore the same rejection is applied.

As per claim 27, Srinivasan teaches:

The method of claim 25 wherein the advertisement is received on a broadcast channel on which other media is also received. Claim 27 contains the same limitations as claim 13 therefore the same rejection is applied.

As per claim 28, Srinivasan teaches:

The method of claim 25 wherein the metadata is received on a separate broadcast channel from other media. Claim 28 contains the same limitations as claim 14 therefore the same rejection is applied.

As per claim 29, Srinivasan teaches:

The method of claim 18 further comprising storing an advertisement. Claim 29 contains the same limitations as claim 15 therefore the same rejection is applied.

As per claim 30, Srinivasan teaches:

The method of claim 29 wherein the advertisement is stored on a single storage device. Claim 30 contains the same limitations as claim 16 therefore the same rejection is applied.

As per claim 31, Srinivasan teaches:

The method of claim 29 wherein the advertisement is stored on a plurality of storage devices. Claim 31 contains the same limitations as claim 17 therefore the same rejection is applied.

As per claim 32, Srinivasan teaches:

A method for providing advertisements with other media comprising:

reading metadata (see column 32, lines 21-67);

downloading an advertisement based on the metadata (see column 32, lines 21-67); and

displaying the advertisement (see column 32, lines 21-67).

As per claim 33, Srinivasan teaches:

The method of claim 32 wherein the metadata contains a source address (see column 32, lines 21-40).

As per claim 34, Srinivasan teaches:

The method of claim 33 wherein the source address is a Uniform Resource Locator (see column 32, lines 21-40).

As per claim 36, Srinivasan teaches:

A method for providing information about a metadata-selected advertisement comprising:

monitoring the metadata-selected advertisement (see column 34, lines 1-24);

collecting data on the metadata-selected advertisement (see column 34, lines 1-23); and

recording the data (see column 34, lines 1-23).

As per claim 37, Srinivasan teaches:

A system for providing advertisements with other media comprising:

a receiver that receives metadata;

a user input device that receives a user input; and

a processor that selects an object, that reads metadata associated with the object, that selects an advertisement based on the metadata of the object, and that causes the advertisement to be displayed. Claim 37 contains the same limitations as claim 1 therefore the same rejection is applied.

As per claim 38, Srinivasan teaches:

The system of claim 37 wherein the processor selects the object based on the user input. Claim 38 contains the same limitations as claim 3 therefore the same rejection is applied.

As per claim 39, Srinivasan teaches:

The system of claim 37 wherein the receiver also receives other media. Claim 39 contains the same limitations as claim 5 therefore the same rejection is applied.

As per claim 40, Srinivasan teaches:

The system of claim 37 wherein the receiver receives the metadata on a broadcast channel on which the receiver also receives other media. Claim 40 contains the same limitations as claim 6 therefore the same rejection is applied.

As per claim 41, Srinivasan teaches:

The system of claim 37 wherein the receiver receives the metadata on a different broadcast channel from other media. Claim 41 contains the same limitations as claim 7 therefore the same rejection is applied.

As per claim 42, Srinivasan teaches:

The system of claim 37 further comprising a storage unit that stores metadata. Claim 42 contains the same limitations as claim 8 therefore the same rejection is applied.

As per claim 43, Srinivasan teaches:

A system for providing advertisements with other media comprising:

a receiver that receives metadata; and

a processor that reads the metadata, that selects an advertisement based on the metadata, and that causes the selected advertisement to be displayed. Claim 43 contains the same limitations as claim 18 therefore the same rejection is applied.

As per claim 44, Srinivasan teaches:

The system of claim 43 wherein the receiver also receives other media. Claim 44 contains the same limitations as claim 19 therefore the same rejection is applied.

As per claim 45, Srinivasan teaches:

The system of claim 43 wherein the receiver receives the metadata on a broadcast channel on which the receiver receives other media. Claim 45 contains the same limitations as claim 20 therefore the same rejection is applied.

As per claim 46, Srinivasan teaches:

The system of claim 43 wherein the receiver receives metadata on a different broadcast channel from other media. Claim 46 contains the same limitations as claim 21 therefore the same rejection is applied.

As per claim 47, Srinivasan teaches:

The system of claim 43 further comprising a storage unit that stores the metadata. Claim 47 contains the same limitations as claim 22 therefore the same rejection is applied.

As per claim 48, Srinivasan teaches:

A system for providing advertisements with other media comprising:

a receiver that receives metadata; and a processor that reads the metadata, that causes an advertisement to be downloaded based on information contained in the metadata, and that causes the advertisement to be displayed. Claim 48 contains the same limitations as claim 32 therefore the same rejection is applied.

As per claim 49, Srinivasan teaches:

The system of claim 48 wherein the receiver also receives other media. Claim 49 contains the same limitations as claim 5 therefore the same rejection is applied.

As per claim 50, Srinivasan teaches:

The system of claim 48 wherein the receiver receives the metadata on a broadcast channel on which the receiver also receives other media. Claim 50 contains the same limitations as claim 6 therefore the same rejection is applied.

As per claim 51, Srinivasan teaches:

The system of claim 48 wherein the receiver receives metadata on a different broadcast channel from other media. Claim 51 contains the same limitations as claim 7 therefore the same rejection is applied.

As per claim 52, Srinivasan teaches:

The system of claim 48 further comprising a storage unit that stores the metadata. Claim 52 contains the same limitations as claim 8 therefore the same rejection is applied.

As per claim 53, Srinivasan teaches:

A system for providing information about a metadata-selected advertisement comprising:

a receiver that receives data relating to metadata-selected advertisements;

a processor that monitors the metadata selected advertisements, that collects the data relating to the metadata-selected advertisements, that causes the data to be recorded; and

a storage device that stores the data. Claim 53 contains the same limitations as claim 36 therefore the same rejection is applied.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over Srinivasan et al (U.S. 6,357,042).

As per claim 35, Srinivasan does not expressly teach:

The method of claim 33 wherein the source address is a telephone number. However, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Srinivasan would include in the source address the advertiser's telephone number therefore giving users the advertiser's contact information.

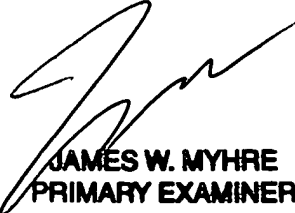
Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 703-306-5933. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ERIC W STAMBER can be reached on 703-305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DL
Daniel Lastra
September 2, 2004


JAMES W. MYHRE
PRIMARY EXAMINER